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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/152,698 09/02/98 MADIYALAKAN

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HM22/0625

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EXAMINER

HUFF, S

ART UNIT

PAPER NUMBER

1642

DATE MAILED:

06/25/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

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Office Action Summary

Application No.

09/152,698

Applicant(s)

Madiyalakan et al

Examiner

Sheela J. Huff

Group Art Unit

1642



☐ Responsive to communication(s) filed on _____

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire zero month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-70 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☐ Claim(s) _____ is/are rejected.

☐ Claim(s) _____ is/are objected to.

☒ Claims 1-70 are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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DETAILED ACTION

Inventorship

1. The petition to correct the inventorship of this nonprovisional application under 37 CFR 1.48(a) is deficient because:

As it appears that a party required by 37 CFR 1.48(a)(1) to submit a statement of facts may not be willing to submit such statement, applicant should consider either: a) submission of a petition under 37 CFR 1.183 to waive that requirement if the original named inventor(s) has assigned the entire right and interest to an assignee who has given its consent to the requested inventorship correction, MPEP § 201.03, Verified Statement of Facts, or b) refiling the application (where addition is needed under 37 CFR 1.53(b) with a new oath or declaration and any necessary petition under 37 CFR 1.47, or where only deletion is needed, either under 37 CFR 1.53(b) utilizing a copy of a prior oath or declaration 37 CFR 1.63(d)(iii), or under 37 CFR 1.53(d)), thereby eliminating the need for a 37 CFR 1.48 petition.

Election/Restriction

2. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-25, 32-60 and 68, drawn to methods and compositions involving binding agent-antigen complexes and inducing/altering the immune response, classified in class 424, subclass 130.1+.
 - II. Claim 26, drawn to designing new drugs, classified in class 435, subclass 7+.

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- III. Claims 27-29, drawn to a method of treatment using a binding agent bound to a photosensitizer, classified in class 424, subclass 178.1+.
 - IV. Claims 30-31, drawn to stimulating antibody production to a complex formed by binding agent-antigen and making antibodies specific for the newly exposed domains, classified in class 530, subclass 387.1+.
 - V. Claims 61-63, drawn to a composition comprising modified antigens, classified in class 530, subclass 387.1+.
 - VI. Claims 64-67 and 69-70, drawn to compositions and methods involving tertiary antibodies, classified in class 530, subclass 387.1+.
3. The inventions are distinct, each from the other because of the following reasons: Inventions I-VI are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are unrelated. Group II is unrelated to Groups I and III-VI because it involves the making of new drugs and none of the other methods do this. Group III is unrelated to the other groups because it involves the use of a complex of binding agent and photosensitizer and none of the other groups do., Group IV is unrelated to any of the other groups because it involves making antibodies to a complex that is conformation specific. Group V is unrelated to the other groups because it involves a modified agent and none of the other group do. Group VI is

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unrelated to any of the other groups because it's compositions and methods use anti-anti-ID's. Group I is unrelated to any of the other groups because it only involves a binding agent.

4. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.
5. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.
6. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).
7. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).
8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sheela J. Huff whose telephone number is (703) 305-7866. The Examiner can normally be reached on Monday and Thursday from 5:30am to 2:00pm.

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If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Anthony Caputa, can be reached on (703)308-3995.

The FAX phone number for the group is (703)308-4242.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703)308-0196.

Sheela J. Huff
June 21, 2001


Sheela J. Huff
Primary Examiner